

### **REMARKS**

Reconsideration and withdrawal of the rejections set forth in the Office Action dated November 29, 2005 are respectfully requested. The applicants' representative wishes to thank the Examiner for the thorough Office Action, particularly for the citations to relevant portions of the applied references. Claims 1-18 are pending in the application. The applicants respectfully believe that the claims are patentable for the following reasons.

The applicant has attempted to contact the Examiner and schedule a telephone interview, without success. Should the current Response not place the application in condition for allowance, applicant formally requests a telephonic interview with the Examiner before the issuance of a subsequent Office Action in order to discuss any of the Examiner's concerns.

Embodiments of the invention will now be discussed, followed by a discussion of the applied references. Next, distinctions between the claims and the applied references are discussed<sup>1</sup>.

#### **Embodiments of the Claimed Invention**

Embodiments of the claimed invention are directed to a system that stores files (such as digital documents, graphics files, and so on) in locations apart from profiles that accompany different versions of a file. For example, Figure 1 shows a computer system 100 with a profile storage location 108 and other storage location 110.

For example, a software application, such as Microsoft Word, creates a file. At some point, a profile that corresponds to that file also is created. This profile contains, among other things, settings that are specific to the file and are used by the software application when a user is working with the file. For example, a user may elect an

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<sup>1</sup> Silence regarding a position taken by or argument made by the Examiner does not indicate any acquiescence to that position or argument. Furthermore, arguments made with respect to a particular claim or claims apply only to that claim or claims, and not to other claims, unless specifically noted herein.

"autocorrect" setting within the software application when using the file. When the user is finished with the file, the system stores the file and also stores the profile. In this example, the profile includes, among other things, information that the autocorrect setting was enabled. The next time the system retrieves the file, the system will also retrieve the corresponding profile. Therefore, in a subsequent retrieval and use of the file, the autocorrect function will already be enabled, because the saved profile containing this setting will be retrieved along with the file (Specification, paragraph [0024]).

#### The Curtis Reference

Curtis is directed to a method and system for managing environments with a data processing system. These environments, called Object Management Environments (OMEs), are "mechanism[s] or system[s] for managing classes, objects, messaging, etc., in a data processing system environments and includes objects being managed" (Curtis, column 4, lines 44-47). Furthermore, "the OME consists of control structures and supporting functions that tie together all aspects of the operating system environment within a central, logically single, controlling entity..." (Id., column 4, lines 49-53). Figure 3 of Curtis shows the structure of an OME, including an anchor block 204 and other connected blocks 206a-206n. Some of these other blocks contain "data defining class ranges, such as class names and class numbers," "loaded class information," "global unit[s] of work," "processing flags," and so on (Id., column 5, lines 10-21). Using these OMEs, Curtis aims to "provide a method and system for improving the efficiency of an environment established in a data processing system by reducing the initialization required time for the environment" (Id., column 1, lines 50-55). In some embodiments, two or more applications share an environment, which can improve the efficiency of the initialization of the applications as an environment is utilized by more than one application (Id., abstract).

#### The Iwashita Reference

Iwashita is directed to an ultrasonic module and ultrasonic diagnostic system. The system includes an ultrasonic probe and a corresponding computer system (Iwashita,

Figure 1). In some embodiments, the computer system is capable of displaying "at a time of a re-examination, to again obtain signals for producing images, using said ultrasonic module, on a patient specified by the patient ID recorded in anyone of the diagnostic files produced at the past, image recorded on the diagnostic file produced at the past on the same patient" (Id., column 6, lines 43-48).

#### Rejections under 35 U.S.C. § 103

Claims 1-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,896,531 to Curtis et al. in view of U.S. Patent No. 5,758,649 to Iwashita et al.

As stated in section 2142 of the Manual of Patent Examining Procedure ("MPEP"), "to establish a *prima facie* case of obviousness, three basic criteria must be met." The three criteria are: (1) "the prior art reference (or references when combined) must teach or suggest all the claim limitations," (2) "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vick*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)," and (3) "there must be a reasonable expectation of success."

As explained below, applicant respectfully submits that all three of these criteria are lacking.

#### A. Independent Claim 1

Claim 1 recites, *inter alia*, a computer system comprising

"a file, the file having an associated profile that specifies parameters associated with a previous instance of the file used by the software application for at least the purpose of

preparing the software application to display the file upon its retrieval by the software application," and,

"a storage management module that distributes stored files and associated profiles among the plurality of storage media according to predetermined patterns, one of such predetermined patterns being separate storage of a file and the file's corresponding profile."

B. The Applied References, Even in Combination, Lack the Recited Combination of Elements that Provide the Above Computer System

As described above, Curtis is directed to managing environments in data processing systems using Object Management Environments. These OMEs tie all aspects of an operating system environment together within a central, logically single, controlling entity by containing control structures and supporting functions.

The Office Action appears to equate an "OME" described by the Curtis reference with a "profile" as recited in claim 1. For example, the Office Action explains that Curtis "teach substantially...a storage management module that distributes stored files and their accompanying environments....being separate storage of a file and the file corresponding environments" (Office Action, paragraph 4). Claim 1, however, recites "a storage management module that distributes stored files and their accompanying profiles....being separate storage of a file and the file corresponding profiles" (Emphasis Added).<sup>2</sup> Applicant respectfully submits that an "environment" is not a "profile," as explained below.

Looking to Curtis, the portions cited in the Office Action relate to the functionality of an OME in the system of Curtis, such as the OME functionality described above. An OME is different than a "profile" as recited in claim 1. Claim 1 recites that a profile "specifies

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<sup>2</sup> The Office Action presents arguments by reciting elements directly from each claim with sections in references that allegedly teach such elements. However, in each instance where the claim recites "profile," the Office Action uses "environment." This further indicates the Office Action's reliance on equating the environments of Curtis with the profiles of the claimed invention, which is incorrect.

parameters associated with a previous instance of the file used by the software application for at least the purpose of preparing the software application to display the file upon its retrieval by the software application." For example, profiles relate to created files and store settings from software applications that created those files. In contrast, OMEs control the data processing of an operating system. As described above, OMEs manage classes, objects, messaging, etc. in a data processing environment. Profiles do not manage data in systems, and for at least this reason, cannot be equated with the OMEs of Curtis. A profile, therefore, is not an Object Management Environment, and the Office Action is incorrect in attempting to equate the two.

Furthermore, because Curtis does not disclose "profiles" as recited in claim 1, Curtis cannot disclose "separate storage of a file and the file's corresponding profile" that is also recited in claim 1.

The Iwashita reference does not satisfy these deficiencies. The Office Action relies on Iwashita merely "to teach the use of a previous file instance" (Id., paragraph 5). Also, Iwashita is directed to an ultrasonic module and system, and does not disclose associating profiles with files and storing the profiles in separate locations from where files are stored.

Therefore, for at least these reasons, the Office Action has not established the first basic criterion for a *prima facie* case of obviousness because the combination of Curtis in view of Iwashita does not disclose each and every element of the claim.

C. The Applied References Lack a Sufficient Suggestion to Combine Them As Argued in the Office Action

According to the MPEP and controlling case law, the motivation to combine references cannot be based on mere common knowledge and common sense as to benefits that would result from such a combination, but instead must be based on specific teachings in the prior art, such as a specific suggestion in a prior art reference. The Office Action, however, does not supply a motivation taken from specific teachings in the prior art.

The Office Action at paragraph 6 states that "it would have been obvious to one skilled in the art at the time of the invention to combine the teachings of Curtis and Iwashita because Iwashita's method of using the previous file instance would improve Curtis's system by allowing the instance to be reused thus improving processing."

Applicant respectfully disagrees. The Office Action's purported motivation of "using the previous file instance would improve Curtis's system by allowing the instance to be reused thus improving processing" is found neither in Curtis nor Iwashita. Furthermore, there is no indication in Curtis that the use of "previous file instances" would benefit the speed of initialization of a data processing environment that controls data processing within an operating system.

Neither Curtis nor Iwashita discusses reusing instances to improve processing. Curtis discusses the need for "a method and system for reducing the time necessary to provide a data processing environment for a particular task" (Curtis, column 1, lines 40-42). Curtis aims to solve the problem of quickly initializing data processing environments for computer system. Iwashita does not provide any disclosure that would assist in the initialization of data processing environments. One of ordinary skill in the art would, therefore, not look to Iwashita's ultrasound module and system (that may utilize a patient's previous ultrasound data, or as the Office Action states, its file instance) to solve such problems.

Possibly more importantly, the two references are in disparate art fields, and are thus non-analogous. Additionally, the two references are not in the field of endeavor of the claimed invention. The claimed invention is directed to the storage of files and profiles within a computer system. Curtis is directed to a system for managing environments within a data processing system. Iwashita describes an ultrasonic module and system. Clearly, systems directed to file/profile storage and ultrasonic diagnostic systems are in different fields of endeavor. Thus, one skilled in the art would not be motivated to combine teachings from such disparate, non-analogous references, let alone in the combination as

argued<sup>3</sup>. The Office Action has not met the second basic criterion, and therefore does not establish a *prima facie* for obviousness.

D. There is No Reasonable Expectation of Success in Combining the Two References

As discussed above, the Curtis and Iwashita are from disparate art fields. Neither reference provides discussion for a possible combination with the other (or with references from the other's art field), let alone providing any expectation that the purported combination would be successful. Other than using the teaching of the claimed invention, the applicant cannot find any motivation or suggestion that would lead one of ordinary skill to combine the object management system of Curtis with the ultrasonic module and system of Iwashita.

Therefore, the applied references, even in combination, lack a sufficient suggestion to combine them as argued in the Office Action and do not present a reasonable expectation of success in combining the two. For at least these reasons, the references as combined cannot render the claim obvious. The Office Action has not met the third basic criterion, and therefore does not establish a *prima facie* for obviousness.

The Office Action has not met the three basic criteria for obviousness as set forth in section 2142 of the MPEP and applicant respectfully submits that claim 1 is patentable over the combination of Curtis in view of Iwashita.

C. Independent Claims 8 and 15

Independent claims 8 and 15 recited elements similar to those recited in claim 1, including:

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<sup>3</sup> MPEP Section 2141.01(a) states that a reference must either be in the field of the applicants' endeavor or reasonably pertinent to the particular problem with which the inventor was concerned. (Citing *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992).)

"a plurality of storage media that are selectively used by the processor to store the application specific profiles separately from the files" (claim 8), and

"storing the file and the associated profile to separate storage locations in the computer system" (claim 15).

Therefore, for at least the reasons stated above, claims 8 and 15 are likewise patentable over the combination of Curtis in view of Iwashita.

#### Conclusion

Overall, none of the applied references, singly or in any motivated combination, teach or suggest the features recited in independent claims 1, 8 and 15 and thus such claims are allowable. Since these independent claims are allowable, based on at least the above reasons, the claims which depend from them are likewise allowable. If the undersigned representative has overlooked a relevant teaching in any of the references, the Examiner is requested to point out specifically where such teaching may be found.


In view of the foregoing, the claims pending in the application patentably define over the applied art. A Notice of Allowance is, therefore, respectfully requested. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned at (206) 359-3090.



Applicant encloses a check to cover the extension of time fee, and believes no additional fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-0665, under Order No. 606928001US from which the undersigned is authorized to draw.

Dated: May 30, 2006

Respectfully submitted,

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